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In re Application of VANDERBIST et al.

Application No.: 09/424,247

PCT No.: PCT/BE98/00064

Int. Filing Date: 07 May 1998

Priority Date: 07 May 1997

Attorney Docket No.: 4068-0002-0 PCT

For: DRY POWDER INHALER EXCIPIENT,
PROCESS FOR ITS PREPARATION AND
PHARMACEUTICAL COMPOSITIONS CONTAINING IT

DECISION ON REQUEST
FOR RECONSIDERATION
OF PETITION TO ACCEPT
DECLARATION UNDER
37 CFR §1.47(a)

This is a decision on applicants' "Request for Reconsideration of Decision on Request for reconsideration of Petition to Accept Declaration under 37 CFR 1.47(a)" requesting the acceptance of the application without the signature of named co-inventor, Paul Maes. The reconsideration was filed 29 May 2001 in the United States Patent and Trademark Office (USPTO) in the above-captioned application. The request for reconsideration was accompanied by a "Request for Extension of Time" of four months, which is granted.

BACKGROUND

On 30 November 1999, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee, a petition to revive an unintentionally abandoned application under 37 CFR §1.137(b), a declaration executed by two of the three named inventors and a petition to accept Declaration under 37 CFR §1.47(a).

In a decision mailed 02 May 2000, the petition to revive was granted; however, the petition to accept declaration under 37 CFR §1.47(a) was dismissed on the grounds that applicant had failed to provide factual proof that the non-signing joint inventor, Paul Maes, refused to execute the application or could not be reached after diligent effort.

On 27 September 2000, applicants' filed a Request for Reconsideration of Decision to Dismiss Petition under 37 CFR 1.47(a). The Reconsideration was accompanied by a declaration of Philippe Baudier and exhibits. The Exhibits include (1) an alleged assignment, written in French, from nonsigning inventor Paul Maes to Pharylse, (2) a copy of an envelope addressed to Paul Maes, at Biovail Corporation International, marked "MOVED REFUSED 1 OCT 1999", (3) an envelope addressed to Paul Maes, at his last known residence as noted on the publication bearing a Belgium postmark of 14 July 2000 and (4) 14 August 2000 facsimile letter from Paul Maes, written in French, to Philippe Baudier.

In a decision mailed on 29 November 2000, applicants' request for reconsideration was dismissed without prejudice on the grounds that applicant had failed to demonstrate that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/424,247 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address or identified Mr. Maes' refusal to sign, either in writing or by telephone.

On 29 May 2001, applicants filed a "Request for Reconsideration of Decision on Request for reconsideration of Petition to Accept Declaration under 37 CFR 1.47(a)" and "Request for Extension of Time" along with the appropriate fees and copies of relevant correspondence. Counsel also included a copy of an English translation of the assignment.

On 31 May 2001, applicant supplemented the request for reconsideration with a copy of a document entitled "Invention Process" signed by Francis Vanderbist and Philippe Baudier.

DISCUSSION

In his petition, counsel for applicant states that on 20 March 2001, he forwarded a copy of the application to Paul Maes. Petitioner has now demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/424,247 (specification, including claims, drawings, and a combined declaration and power of attorney) to the nonsigning inventor for his signature. Mr. Maes' reply dated 26 March 2001 indicates that he received the application.

Along with the request for reconsideration, counsel submitted copies of a series of written exchanges between himself and the non-signing inventor, including copies of his correspondence to Mr. Maes dated 20 March, 28 March, 29 March (with attached corrected declaration and power of attorney), 11 April, 19 April, and 11 May 2001. Counsel also included copies of letters, emails or facsimiles from Mr. Maes to counsel dated 26 March, 28 March, 30 March, 06 April, 27 April, 10 May, and 25 May 2001.

However, the evidence submitted with the request for reconsideration does not support the conclusion that Mr. Maes refuses to sign. Specifically, Mr. Maes' letter dated April 27, 2001 states, in pertinent part,: "I never said that I wouldn't sign the declaration, but given your history with Mr. Baudier and 'again' your apparent attempt to potentially remove my name from one of my inventions, **I have difficulty in giving you any power of attorney.**" [Emphasis added.]

This statement of Mr. Maes is not considered a refusal to sign the application but a refusal to give counsel power of attorney to prosecute the application. Although counsel's numerous letters continue to request Mr. Maes' signature on the declaration, in actuality, counsel has requested Mr. Maes' signature on a combined declaration and power of attorney, provided by counsel. The inventor is not required to sign a power of attorney but to sign a declaration to continue prosecution of this case. Therefore, it cannot be concluded that the nonsigning inventor's conduct constitutes a refusal given the facts provided by the documentary evidence (Mr. Maes' letter).

Furthermore, counsel's petition does not satisfy 37 CFR 1.47(a) in that it does not Mr. Maes' last known address.

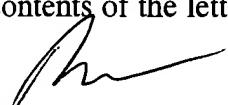
In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No additional petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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